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09/942,061	08/29/2001	Bobby Hu	CFP-1080CA	8157

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EXAMINER

SHAKERI, HADI

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 04/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,061

Applicant(s)

HU, BOBBY

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-25 and 40-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25 and 40-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/541,193 (6,282,992).
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 46-48, 50, 51, 54, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 42 is directed to a handle for a ratcheting tool, whereas claims 46-48, 50, 51, 54 and 55 are directed to a handle in combination comprising, e.g., a drive member, pawl...that appears to be a different invention, thereby rendering the scope of the claim(s) unascertainable.

#### *Claim Rejections - 35 USC § 102*

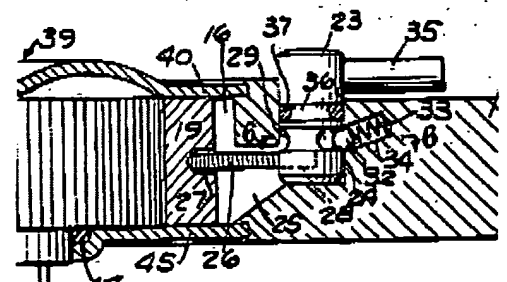
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hare, US Patent No. 2,957,377.

Hare meets all the limitations of claim 42, i.e., a hole (13), a cavity (25) communicating with the hole, a



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compartment (24) spaced from a first face, and a bridge, the compartment communicating with outside through the cavity and the hole.

Regarding claim 43, PA meets the limitations, i.e., end wall defining an opening having a smaller diameter than the hole.

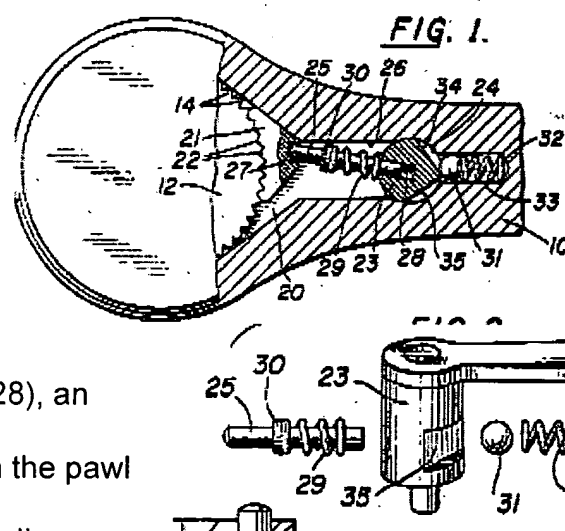
### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21, 23, 41, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilness, US Patent No. 3,265,171 in view of Tuttle, US Patent No. 1,426,127.

Kilness discloses all the limitations of claim 21, i.e., a drive member including a plurality of teeth, a pawl (21) including a first side with teeth (22) and a second side with a recess (27), a switch member including a turn piece (36), an actuating plate (23) with a first receptacle (28), an elastic element (29), a peg (25) with a first end received in the pawl and a second end received in the first receptacle and including a second receptacle (receiving the spring) with a second end wall (30), with the elastic member located between the first end wall and the second end wall, except that it does

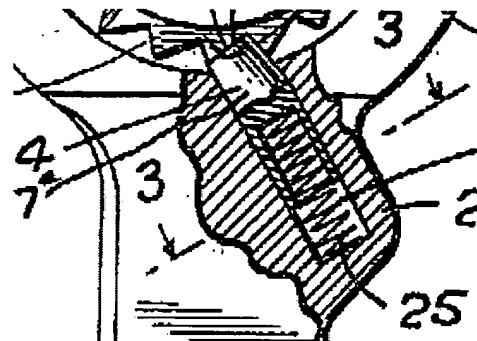


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*S*  
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*S* *W*

not disclose the elastic member to be located in the first receptacle. Different

embodiments of actuating member, in which the elastic member is located in a peg's receptacle and a second receptacle having an end wall against which the elastic member is biasing against, is old and known in the art as illustrated by Tuttle. Further, applicant has not disclosed that

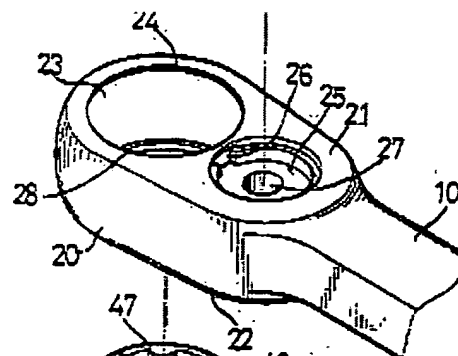


utilizing this embodiment solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the actuating means as disclosed by other embodiments. It is known in the art, as shown by Tuttle, to use a peg having a receptacle and an elastic member located in the peg's receptacle and another receptacle to biased the peg. The two are art recognized functional equivalents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Kilness by replacing the actuating means, in view of Tuttle, as the two are art recognized functional equivalents.

Regarding claims 23, 41, 57-59, Prior Art (PA) meets the limitations.

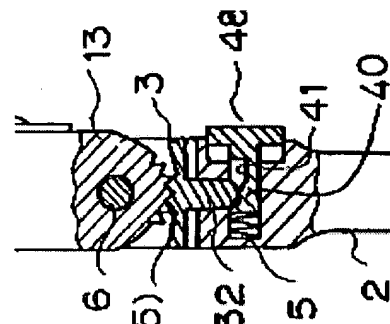
8. Claims 42-45, 49, 52, 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow, US Patent No. 5,533,427 in view of Chiang, US Patent No. 6,000,302.

Chow meets all the limitations of claim 42, i.e., a hole (23), a cavity (26) communicating with the hole, a compartment (25) spaced from a first face, and a bridge,



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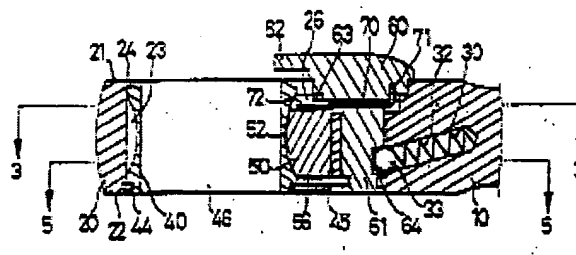
except for the compartment to be communication with outside through the cavity and the hole. Chiang teaches a tool having a handle with a hole, cavity and compartment in which the compartment is communication with outside through the cavity and the hole. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the handle of Chow with the compartment as taught by Chiang to strengthen the handle.



Regarding claim 43, 44, 45, 49, 52, 53 and 56, PA meets the limitations.

9. Claims 22, 25, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art (Kilness in view of Tuttle) as applied to claim 21 above, further in view of Chow.

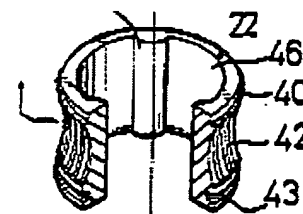
Prior art as described above meets all the limitations of claim 22, except for the drive member to be a gear wheel. Chow teaches a ratchet wrench with a gear wheel. It would have been



obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the modified tool of prior art with a gear wheel as taught by Chow to adapt the tool ~~for~~ <sup>with</sup> a gear wheel for engaging with like fasteners.

Regarding claim 25, PA meets the limitations, i.e., first annular groove (28), a second annular groove (43), and a C-clip (44).

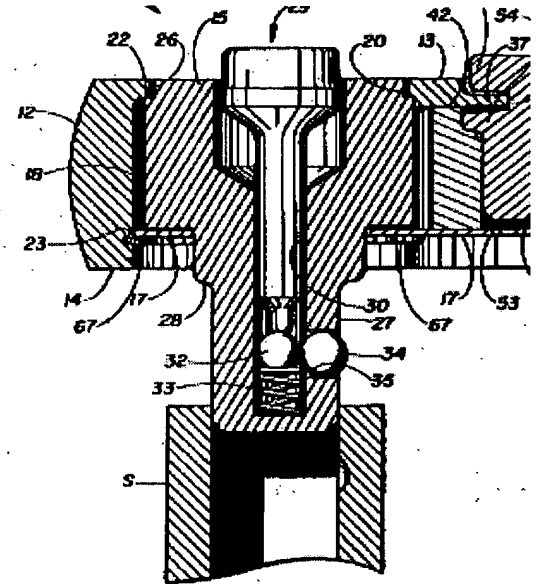
Regarding claim 40, PA meets the limitations.



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10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art (Kilness in view of Tuttle) as applied to claim 21 above, further in view of Arnold et al., US Patent No. 5,178,047.

Prior art as described above meets all the limitations of claim 24, except for the end wall and the stub. Arnold et al. teaches a ratchet wrench with a head having an end wall (26) and a drive member with a stub (29). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Kilness with a drive member with a column as taught by Arnold et al. to adapt the tool for engaging with like fasteners having quick release mechanism.



### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**12.** Claims 21-25, 40-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed, i.e., a peg having a receptacle and a head as shown in Figs. 2 and 7 is fully disclosed in the above mentioned US Patent, Figs. 2 and 9.

**13.** Claims 42-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,282,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed, i.e., a head as shown in Figs. 2 and 7 is fully disclosed in the above mentioned US Patent, Figs. 2, 7 and 9.

**14.** Claims 21-25, 40-41 and 57-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,282,991 in view of Kress. The above-mentioned US Patent discloses all the limitations except for a peg with a receptacle. Kress, Figs. 1 and 2 discloses a switch member actuating the pawl with a spring-loaded plunger, spring loaded peg as



illustrated by Kress is old and known in the art. It is known in the art, to use spring loaded peg or a pin to shift the pawl. The two are art recognized functional equivalents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Patent by replacing the actuating member with a peg including a receptacle, in view of Hsieh, as the two are art recognized functional equivalents.

15. Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/814,430<sup>6,453,779</sup> in view of McCann. Because subject matter claimed, i.e., a peg having a second receptacle and a head is disclosed in the above mentioned US application, Figs. 2, 7 and 9. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member. As indicated in the cited reference McCann, Figs. 1 and 2, these limitations and embodiment are old and known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application by replacing the head, with one as disclosed in McCann as the two are art recognized functional equivalents.

This is a provisional obviousness-type double patenting rejection.

16. Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20

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of copending Application No. 09/923,120 in view of McCann and Chen. Because subject matter claimed, excluding the head as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Figs. 1, 2, 9 and 10. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old and known in the art, and would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application in view of McCann and Chen as functional equivalents known in the art.

This is a provisional obviousness-type double patenting rejection.

17. Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 2002/0112537 in view of Fosella, Kress, McCann and Chen. Because subject matter claimed, i.e., the pawl, switch member, and elastic member are disclosed in the above-mentioned US application, Figs. 1, 2, 9 and 10, except for a peg having a second receptacle with a second end wall, a head with an opening and the drive column. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and

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embodiment are old. Regarding the peg with the receptacle Fosella, Figs. 3 and 5 discloses a switch member actuating the pawl with a spring-loaded plunger 130, thus spring loaded peg as further illustrated by Kress, Figs. 1 and 2., is old and an and would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application in view of prior art as functional equivalents known in the art.

This is a provisional obviousness-type double patenting rejection.

18. Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/888,810 <sup>2002/0166416</sup> in view of McCann and Chen. Because subject matter claimed, i.e., as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Fig. 6. See above

This is a provisional obviousness-type double patenting rejection.

### **Conclusion**

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Response to Arguments***

20. Applicant's arguments filed 3/06/02 have been fully considered but they are moot in view of the new ground(s) of rejection.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken, as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by

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what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, prior art is used to indicate different embodiments of the art recognized functional equivalence.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

21. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.



Joseph J. Hail, III  
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Technology Center 3700

HS



March 27, 2002